

### III. REMARKS

Applicant requests that the Examiner withdraw the restriction requirement. The Examiner's statement in the Office Action that the mere naming of a species as patentably distinct suffices the requirements under MPEP § 803 and 806.05 is incorrect. Applicant reaffirms the previously stated grounds for traverse of the restriction, which is incorporated herein by reference. Applicant notes again that the mere naming of species as patentably distinct does not make those species patentably distinct and clearly is not the showing required from the Examiner by the MPEP to establish a *prima facie* case for the restriction requirement. The Applicant here is not stating whether or not the noted species are indeed patentably distinct, but merely that the restriction as initially required and now made final, was and is defective. Further, the Applicant resubmits that pursuant to M.P.E.P. § 803, restriction is proper when the search and examination of an entire application cannot be made without "serious burden". If the search and examination of an entire application "can be made without serious burden" the Examiner "must" examine it on the merits, even though it includes claims to independent or distinct inventions. The Examiner has not asserted that there are independent or distinct inventions, and has certainly not provided any reasoning as to why the entire application could not be examined without serious burden. The Examiner has also not made any showing regarding the various classes or subclasses into which the claims would be classified.

It should also be noted that although restriction may be required to one of two or more independent and distinct inventions, 37 C.F.R. § 1.141 provides that a reasonable number of species may still be claimed in one application. (See M.P.E.P. § 806.04(a)).

It is noted, that the above is not and should not be construed as either an admission or confirmation that the noted species are or are not patentably distinct. Rather, it is a notation that the Restriction as made is defective and should be withdrawn.

Therefore, Applicant requests that the requirement for restriction be withdrawn because the requirement is defective in that no reasons are provided for the restriction requirement, and the examination of the application would not pose a "serious" burden on the Examiner.

Claim 1 is amended. Applicant appreciates the indication of allowable subject in claims 2, 5 and 6 but submits that the claims are patentable as currently presented.

Claims 1 and 4 are patentable under 35 U.S.C. 102(b) over Blake, III, U.S. Patent No. 5,281,220 ("Blake"). Claim 1 recites first and second lever members mounted on the handle for grasping engagement by other fingers of the operator. Claim 1 further recites that the first and second lever members are positioned relative to the finger loop so that the operator can reposition the other fingers between the first and second lever members with rotation of the finger within the finger loop while operating the medical device with the finger within the finger loop. Blake fails to disclose or suggest the first and second lever members are positioned relative to the finger loop so that the operator can reposition the other fingers between the first and second lever members with rotation of the finger within the finger loop while operating the medical device with the finger within the finger loop.

Blake discloses an endoscopic instrument (10) comprising an instrument housing or frame (12), a handle assembly (14) an

elongated tube (16) projecting from the instrument housing and encasing an actuating linkage (18) and operating components (20) projecting from the far end of the tube (Col. 2, L. 42-48). The instrument housing comprises right (22) and left (24) plates (Col. 2, L. 50-51). The handle assembly (14) includes a stationary hand grip (32) depending from the housing and terminating in finger loop (34) which in normal use receives at least one finger, usually the ring finger. A recess or notch (36) in the hand grip above the loop accommodates the middle finger. (Col. 2, L. 57-62). The handle assembly in Blake also comprises a moveable hand lever (40) pivotally attached to the housing and having at its lower end a finger loop (44) for receiving a surgeon's thumb. Blake also discloses a slide member including a cylinder or barrel cam (66) fitted over the tube (16). The cylinder (66) is connected to finger loop (68) for engagement by an index finger. (Col. 3, L. 43-48). Moving the cylinder (66) along the tube (16) will rotate the tube (Col. 3, L. 54-58).

Nowhere does Blake disclose or suggest the first and second lever members are positioned relative to the finger loop so that the operator can reposition the other fingers between the first and second lever members with rotation of the finger within the finger loop while operating the medical device with the finger within the finger loop as recited in Applicant's claim 1. The device of Blake specifically discloses which of the surgeon's fingers goes in which finger loop. The surgeon's index finger goes in finger loop (68), the surgeon's thumb goes in finger loop (44) while the surgeon's ring finger goes in finger loop (34). If a surgeon tries to reposition his fingers using the device in Blake, the device would become unstable. If the surgeon in Blake tries to reposition the index finger from finger loop (68) to

finger loop (34) the device is only supported by the thumb in finger loop (44) of the movable hand lever (40) which would cause the device to move undesirably due to the device not being supported by the surgeons hand and the pivoting action of the handle (40). Moreover, if the surgeon only has a thumb in finger loop (44) of the movable handle (40), the device in Blake cannot be properly operated (e.g. the scissor blades (48) would undesirably open and close). There is absolutely no disclosure or suggestion of repositioning the surgeon's fingers while operating the medical device as called for in claim 1.

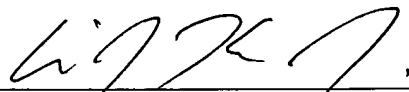
Furthermore, in Blake, only finger loop (44), which is attached to hand lever (40), can be used to open and close the scissor blades (48) using the actuating linkage (18). Hand grip (32) and finger loop 34 of Blake are stationary while finger loop (68) and cylinder (66) merely rotate the tube (16). This is not what is called for in Applicant's claim 1. Claim 1 calls for any one of the finger loop and the first and second lever members being able to operate the medical device through the force transmitting member.

Therefore claim 1 is patentable over Blake. Claims 2 and 4-6 depend from claim 1. While these dependent claims each contain their own patentable subject matter, these claims are allowable at least because of their respective dependencies.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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